

## REMARKS

In the Office Action dated January 21, 2005, claims 23-31 were withdrawn from consideration, claims 11 and 13-19 were rejected under 35 U.S.C. §102(b) as anticipated by Rosenbaum et al., U.S. Patent No. 5,031,223 and claims 21 and 22 were rejected as unpatentable over Rosenbaum et al. in view of the IBM reference submitted by applicant, or in view of Koenck, U.S. Patent No. 6,688,523, or in view of Patel et al., U.S. Patent No. 6,766,955.

The Office Action characterized claim 23 as a “subcombination” claim directed to Group III of the restriction requirement. However, claim 23 adds limitations and therefore cannot be a subcombination of now-canceled claim 11. Rather, the reverse is true, canceled claim 11 could have been considered a subcombination of claim 23. Claim 23 has been amended to depend from new independent claim 32 which is deemed to be allowable. Reinstatement of claim 23 is therefore requested.

Applicant has canceled claims 11, 13-15, 21 and 24-31, amended claims 16-20 and 22-23 and added new claims 32-36. Applicant submits that new independent claim 32, along with dependent claims 16-20, 22-23 and 33-36 are allowable as set forth below.

Rosenbaum et al., U.S. Patent No. 5,031,223 discloses a system wherein mail pieces are placed on a conveyor 12 for automated OCR image capture of the mail piece. (col. 5, lines 64 - col. 6, line 15, Figure 2). A bar code printer is used to print a serial number (*not* a postal zip code) on the mail piece for future identification of the mail piece. (col. 5, lines 64 - col. 6, line 15). The image is analyzed to resolve only the city/state/zip line of the address and the result is output and used to sort the mail pieces for delivery to the destination city and state while resolution of the remainder of the address (addressee, street name and street number) is deferred.

(col. 5, lines 57-63). While the mail pieces are being transported to their respective city and state destinations, the remainder of the images are processed off line to resolve the addressee, street name and street number for the mail pieces. (col. 7, lines 46-62). The resolved addressee, street name and street number for the mail pieces is then transmitted to the destination of the mail pieces where the information is used along with the serial numbers printed on the mail pieces to sort the mail to delivery order. (col. 7, line 63 - col. 8, line 41).

In contrast, the method of the invention of new independent claim 32 is directed to a method including manual imaging of a mail piece wherein an operator selects a region of interest on the surface of a mail piece before scanning the mail piece. At least one of the imager and the mail piece are manually positioned such that the imager is directed to the region of interest on the surface of the mail piece and an image of the region of interest is captured with the imager. A signal including image data representing the captured image is transmitted to a computer which process the image data to determine a destination address. A postal zip code corresponding to the destination address is determined and a bar code representing the zip code is applied to the mail piece. Support for the foregoing is found in ¶¶ [0030] and [0037] of the specification.

Rosenbaum et al. does not teach, suggest or disclose these steps. Specifically, Rosenbaum et al. do not teach first selecting a region of interest on a side of each mail piece before scanning the mail piece and manually positioning one of an imager and the mail piece so that the imager can capture an image of the region of interest. Rosenbaum et al. also does not teach applying a postal zip code to the mail piece. Since Rosenbaum et al. does not teach these steps, Rosenbaum et al. cannot anticipate claim 32. “A claim is anticipated only if *each and*

*every element [step] as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”* MPEP §2131 (emphasis added).

Claims 16-20, depending directly or indirectly from claim 32, are deemed allowable for the same reasons set forth in connection with claim 32.

Turning to the §103(a) rejection of claim 20, it should first be noted that the IBM reference, is dated 2003, whereas the present application has a priority date of September 20, 2002. Consequently, the IBM reference is not available as prior art with respect to the pending claims.

The §103 rejection of claim 22 based on the combination of Rosenbaum et al. and Koenck or Patel et al. cannot be sustained for two reasons. First, there is no suggestion or disclosure in any of the three references to support the combination. Koenck and Patel et al. were cited as disclosing handheld OCR scanning devices. However, neither Koenck nor Patel et al. mention the use of the devices for scanning mail pieces.

Rosenbaum et al. is directed to a highly automated mail processing system and method utilizing “just in time manufacturing” principles (col. 4, lines 1-2). While Rosenbaum et al. discloses the use of an automated, “state of the art” (col. 4, line 4, col. 5, lines 64 - col. 6, line 15, Figure 2) OCR scanner, there is no mention or suggestion of using a handheld manual scanning device in the reference. Further, Rosenbaum et al., fairly read, teaches away from the use of handheld OCR scanning devices, stating that an advantage of the invention is to “utilize[] the postal system’s current investment in on-line OCR’s.” (col. 5, lines 36-37). *See* MPEP §2145 (“It is improper to combine references where the references teach away from their combination.”)

One seeking to implement the method of Rosenbaum et al., which implicitly requires rapid resolution of city and state data in an initial sort to dispatch mail to a destination location, would not be motivated to slow the process by using a manual, hand held device. Thus, Rosenbaum et al. provides no suggestion that would support the use of the handheld devices of Koenck or Patel et al. in the automated processing system disclosed therein. Absent such teaching, suggestion or disclosure, Rosenbaum et al. cannot properly be combined with Koenck and Patel et al. *See, MPEP §2143.01* (“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.”).

The Office Action stated that the “limitation of the handheld OCR … presents no novel or unexpected results over the OCR scanner used in” Rosenbaum et al. and that the use provided “not stated problem” and “would have been a matter of obvious design choice.” However, this is not a case wherein the differences between the prior art and the claimed invention are dimensions or ranges. In such cases, requiring proof of the critically of the differences in dimensions or ranges may be appropriate. However, in the present application, the conclusory assertion that the use of a handheld OCR is an “obvious design choice” cannot substitute for some suggestion or motivation in the prior art to combine the references. As noted by the Federal Circuit, “the examiner can satisfy the burden of showing obviousness of the combination *only* by showing some *objective* teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(Emphasis added); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) (the factual question of

motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority).

The second reason that the §103(a) rejection fails is that the references, whether taken alone or together do not teach the steps recited in claims 32 and 22. “To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03(emphasis added). The cited references do not teach the steps of first selecting a region of interest on each mail piece processed before scanning the mail piece and then positioning one of an imager or the mail piece so that the imager can capture an image of the region of interest with the destination information therein. Since the references do not teach these steps, the §103 rejection cannot stand.

New claims 33-36 depend, directly or indirectly, from independent claim 32. Applicant submits that the steps recited in claims 33-36, in combination with the attributes of the invention recited in claim 32, are not taught or suggested by the art of record and that the claims are allowable.

It is believed that no additional fee is due. If this is incorrect, the Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 50-1588.

Applicant has made an earnest effort to place the case in condition for allowance.

Favorable action and passage of the case to issue are respectfully requested.

Respectfully submitted,



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